



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Takuma Miyazaki, et al.
For : INFORMATION PROCESSING APPARATUS AND METHOD,
INFORMATION PROVIDING APPARATUS AND METHOD,
AND PROGRAM STORAGE MEDIUM
Serial No. : 09/911,911
Filing Date : July 24, 2001
Examining Attorney : John Manning
Art Unit : 2623
Confirmation No. : 4199

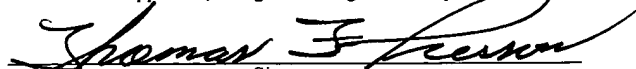
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Name of Applicant, Assignee or Registered Representative



Signature

May 12, 2006

Date of Signature

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop Appeal Brief-Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-145114

Sir:

Applicants request review of the Final Rejection dated January 12, 2006 in the above-captioned application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Please consider the reasons stated herein.

REASONS FOR REQUEST

Claim 1 recites, *inter alia*:

“... display control means for controlling the displaying of said advertisement-associated data received by said receiving means to **display said advertisement-associated data and said television program substantially at same time for a viewer to view said advertisement-associated data while simultaneously viewing said television program.**” (Emphasis added)

Applicants respectfully submit that (1) the combination of Franco, Corvin, and Bennington does not teach the above-recited feature of claim 1; (2) that the applied combination teaches away from the claimed invention; and (3) that the applied combination is improper because it lacks motivation and relies on impermissible hindsight.

The cited portions of Franco, Corvin, and Bennington do not disclose or suggest, displaying the advertisement-associated data and the television program substantially at same time for a viewer to view the advertisement-associated data while simultaneously viewing the television program, as recited in claim 1. The Office Action concedes on page 10 that the combination of Franco and Corvin “fails to disclose displaying said advertisement-associated data and said television program substantially at same time for a viewer to view said advertisement associated data while simultaneously viewing said television program.” The Office Action relies on Paragraph 0097 of Bennington for a teaching of the missing feature. Applicants respectfully submit that Paragraph 0097 of Bennington fails to teach the recited feature of claim 1. Paragraph 0097, and Bennington in general, deal with displaying program schedule information simultaneously with a television program. There is no suggestion or motivation to display advertisement information simultaneously with a television program.

Furthermore, Applicants respectfully submit that MPEP §2141.02 (VI) states that

“A prior art reference must be considered in its entirety, i.e., as a whole, **including portions that would lead away from the claimed invention.** *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).” (Emphasis added)

Indeed, as stated previously, Applicants respectfully submit that both Franco and Corvin teach away from displaying the advertisement-associated data and the television program at the same time, so that a user views simultaneously the advertisement-associated data and the television program. Franco teaches on page 12, paragraph [0133], that “viewers can avoid watching commercials that are not of interest,” which clearly teaches away from a viewer viewing the advertisement-associated data while simultaneously viewing the television program, as recited in claim 1. Corvin teaches on page 3, paragraph [0032], that:

“the insertion of a selected promotion during playback of the recorded program may cause the processor to send, for example, a pause or stop command or signal to halt the playback of the recorded program. After, the promotion is inserted and played, the processor may then send a command or signal to continue the playback of the remaining portion or portions of the recorded program.” (Emphasis added)

Thus, Corvin clearly teaches away from displaying the advertisement-associated data and the television program at the same time, as recited in claim 1.

Finally, Applicants respectfully submit that MPEP §2143.01(III) states that

“**The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.** *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)” (Emphasis added)

Applicants respectfully submit that the Office Action has failed to provide a suggestion or motivation to combine the teachings of Franco and Corvin, and to further modify that combination as allegedly suggested by Bennington. The closest disclosure of a motivation

appears on page 11 of the Office Action: "so as to maximize the viewer's exposure to an advertisement." However, this motivation is not supported by the prior art of record. Indeed, Applicants respectfully submit there is no motivation anywhere in the art of record to suggest the applied combination. Since there is no motivation in the references themselves, the Office Action has relied on impermissible hindsight to create a mosaic of features from the prior art in a futile attempt to create a vague resemblance of Applicants' claimed invention.

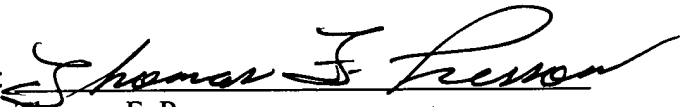
Therefore, for all the reasons stated above, Applicants respectfully submit that claim 1 is patentable.

For reasons similar to those described above with regard to independent claim 1, independent claims 3 and 4 are also patentable.

In view of the foregoing remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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